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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/698,404 | 10/27/2000 | Uwe Schumann | BEIERSDORF 661-WCG | 5395 |

7590 09/17/2002
Norris McLaughlin & Marcus, P.A.
220 EAST 42ND STREET, 30TH FLOOR
NEW YORK, NY 10017

EXAMINER

CHAN, SING P

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1734

DATE MAILED: 09/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/698,404

Applicant(s)

SCHUMANN ET AL.

Examiner

Sing P Chan

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1, 4, 5, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Edenbaum et al (U.S. 4,675,232).

Regarding claim 1, Edenbaum et al discloses a self-release foam laminate. The laminate is formed by combining the polyol and diisocyanated or polyisocyanate in an industrial mixer. (Col 5, line 19-25, Col 6, lines 28-34) The polyurethane mixture is cast onto pressure sensitive adhesive on a release layer, i.e. a backing and cured under heat. (Col 7, lines 20-47) the laminate is wound into roll for storage. (Col 8, lines 10-13)

Regarding claim 4, Edenbaum et al discloses the polyurethane also included crosslinked agent and stearic acid salt. (Col 5, line 64 to Col 6, line 26)

Regarding claim 5, Edenbaum et al discloses the polyurethane mixture is present on the pressure sensitive adhesive composition on the backing. (Col 7, lines 20-34)

Regarding claim 7, Edenbaum et al discloses a single-sided tape obtain by the method. (See abstract)

3. Claims 1-8 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Schumann et al (U.S. 6,129,983).

Regarding claim 1, Schumann et al discloses a self-adhesive tape. The adhesive tape is formed by using a two-part polyurethane composition comprising an isocyanate and a polyol. (Col 2, lines 21-38) The mixture is mixed in a planetary mixer and the mixture is cast on to cured adhesive composition on release paper or release film and is cured by passing the laminate through the drying tunnel at a constant speed. (Col 3, line 65 to Col 4, line 12) Inherently, one the art would wound the laminate into roll for storage.

Regarding claims 2 and 3, Schumann et al discloses a second backing material with cured adhesive composition on the release paper or release film. (Col 4, lines 4-8)

Regarding claim 4, Schumann et al discloses additive can be added to the polyurethane mixture; materials such as dye, (Col 3, lines 5-11) catalysts, (Col 2, line 53) and other additives. (Col 3, lines 24-31)

Regarding claim 5, Schumann et al discloses the polyurethane mixture is positioned on the adhesive layer on the release paper or release film. (Col 3, line 65 to Col 4, line 6)

Regarding claim 6, Schumann et al discloses the backing is a dehesive media. (Col 3, lines 65-67)

Regarding claim 7, Schumann et al discloses a double-sided self-adhesive tape. (Col 4, lines 13-18)

Regarding claim 8, Schumann et al discloses the dehesive media are release paper or release film. (Col 3, lines 65-67)

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schumann et al (U.S. 6,129,983) in view of the admitted prior art.

Schumann et al as discloses in the above 102(e) rejection is silent as to the dehesive media can also include woven, non-woven, and elastomer. However, it is well known and conventional to use backing that include woven, non-woven, and elastomer as shown for example by the admitted prior art. The admitted prior art discloses backing material include all material in web form such as woven, non-woven, and

elastomers and the coating of these web form backing is well established for making self-adhesive articles. (See specification, page 1, lines 33-35 and page 2, lines 28-29)

Response to Arguments

6. Applicant's arguments filed July 30, 2002 have been fully considered but they are not persuasive. In the Edenbaum process, a prepolymer or polymer of polyurethane is formed first and dihydroxy acid is reacted into the polymer chain and the pendant carboxyl groups are then neutralized with an amine. (Col 5, lines 19-43) The polyurethane dispersion is still reactive, since additional curing is required after coating the dispersion onto the release paper with the adhesive. (Col 6, lines 42-44) Therefore, Edenbaum does anticipate the applicants' claimed invention.

7. In response to the applicants' argument that Schumann et al does not teach a continuous process, it is noted Schumann et al discloses a method for forming an adhesive tape. The production of an adhesive tape required a continuous process, such as coating the backing after an in-line corona treatment. (Col 8, lines 11-17) Therefore, Schumann et al does anticipate the applicants' claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sing P Chan whose telephone number is 703-305-3175. The examiner can normally be reached on Monday-Friday 7:30AM-12:00PM and 1:00PM-4:30PM.

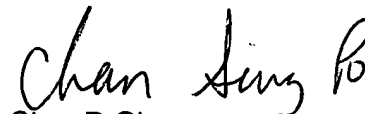
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 703-308-3853. The fax phone numbers for the organization where this application or proceeding is assigned are 703-

Application/Control Number: 09/698,404
Art Unit: 1734

Page 6

872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Sing P Chan
Examiner
Art Unit 1734

spc
September 10, 2002



RICHARD CRISPINO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700